



19 MAY 2003

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In re Application of: HARUNA, Tohru, et al.	:	
U.S. Application No.: 10/009,304	:	
PCT No.: PCT/JP00/03912	:	DECISION ON PETITIONS TO
International Filing Date: 15 June 2000	:	VACATE ABANDONMENT AND
Priority Date: 15 June 1999	:	UNDER 37 CFR 1.42 AND
Attorney's Docket No.: 1858-30	:	37 CFR 1.47(a)
For: NUCLEATING AGENT	:	

This decision is issued in response to the "Request (Petition) To Vacate Erroneously Issued Notice Of Abandonment" filed 16 January 2003 and the "Petition Under 37 CFR 1.42 and 1.47" filed 26 September 2002. Applicant has paid the required petition fee.

BACKGROUND

On 15 June 2000, applicants filed international application PCT/JP00/03912 which designated the United States. On 21 December 2000, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 10 January 2001, applicants filed a Demand for preliminary examination. Based on the timely filing of this Demand, the deadline for payment of the basic national fee extended to thirty months from the international filing date, i.e., 15 December 2001.

On 07 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 01 March 2002, the United States Designated/Elected Office ("DO/EO/US") mailed a Notification Of Missing Requirements indicating that an executed oath or declaration in compliance with 37 CFR 1.497 was required.

On 26 September 2002, applicants filed a response to the Notification Of Missing Requirements that included, among other materials: (1) a declaration executed by surviving inventor Tohru HARUNA, but not on behalf of deceased co-inventor Masayuki TAKAHASHI; (2) the "Petition Under 37 CFR 1.42 and 1.47" considered herein, which seeks acceptance of the application without a signature on behalf of the deceased inventor (the petition asserts that the heiress of the deceased inventor has refused to execute the application); and (3) payment of the fee for a five month extension of time to respond to the Notification Of Missing Requirements.

On 06 January 2003, the USPTO mailed a "Notice Of Abandonment Under 37 CFR 1.53(f) Or (g)" that stated that the application was abandoned.

On 16 January 2003, applicants filed the "Request (Petition) To Vacate Erroneously Issued Notice Of Abandonment" considered herein.

DISCUSSION

A. Petition To Vacate Notice Of Abandonment

Based on applicants' payment of the five month extension fee, the 26 September 2002 submission is considered a timely response to the Notification Of Missing Requirements mailed 01 March 2002. Accordingly, the "Notice Of Abandonment," based as it was on applicants' purported failure to file a proper response to the Notification Of Missing Requirements, is appropriately vacated.

B. Petition Under 37 CFR 1.42 and 1.47(a)

37 CFR 1.42, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by **all** of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

Here, the petition refers to Ms. Yuko Takahashi as "the decedent's wife and legal representative as his heiress-in-law." It is not clear from this statement whether Ms. Takahashi is the appointed legal representative of the deceased inventor or is referred to as such based on her status as an heir of the deceased inventor. Before it can be concluded that Ms. Takahashi alone is the proper person to execute the application on behalf of the deceased inventor, applicants must provide a clear statement either that Ms. Takahashi is the appointed legal representative of the deceased inventor or, in the alternative, that Ms. Takahashi is the sole heir of the deceased inventor and no legal representative is required by the applicable law to be appointed.

Should applicants successfully demonstrate that Ms. Takahashi alone is the proper person to execute the declaration on behalf of the deceased inventor, then her refusal to execute the application papers could be properly considered under 37 CFR 1.47(a), as requested by applicants here and discussed below.

In order for the application to be accepted without the signature of the nonsigning legal representative of the deceased inventor, applicants must submit a grantable petition under 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the proper petition fee, (2) a statement of the last known address of the legal representative; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing legal representative; and (4) factual proof that the legal representative refuses to execute the application or cannot be reached after diligent effort.

The petition here included the required petition fee; item (1) is therefore satisfied. With respect to item (2), applicants have not provided an express statement of the last known address of Ms. Takahashi (this address is apparently contained in the exhibits, but an express statement of such address is not present). Accordingly, item (2) is not satisfied.

With respect to item (3), section 409.03(a) of the Manual of Patent Examining Procedure (“MPEP”) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have submitted a declaration containing an unexecuted signature block for the deceased inventor which references Ms. Takahashi, states here citizenship and relationship to the deceased inventor, and is executed by the surviving inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants’ assert that Ms Takahashi has refused to execute the application in that she has not responded to applicants’ written request for her signature. Before a refusal to execute the application can be claimed, the MPEP § 409.03(d) requires that the nonsigning person be provided with a copy of the complete application, including specification, drawings, and claims. The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.”

Here, the evidence submitted by applicants to demonstrate Ms. Takahashi’s refusal to execute the application is contained in the statement of Hideo Nakano, and the exhibits thereto. These materials show that applicants have made a single mailing to Ms. Takahashi with respect to the present application. It does appear that applicants have presented Ms. Takahashi with the full application papers, as required before a refusal to sign can be asserted. However, the failure to respond to the single correspondence is insufficient to constitute a refusal. A follow up request for signature is required; such request should include a clear statement that the failure to reply within a given time period will be treated as a refusal to sign. Based on the above, the evidence submitted with respect to applicants refusal to execute the application does not satisfy the requirements set forth in MPEP § 409.03(d). Accordingly, item (4) is not satisfied.

Based on the foregoing, even were applicants to successfully demonstrate that Ms. Takahashi is the proper person to execute the application under 37 CFR 1.42, the present materials do not constitute a grantable petition under 37 CFR 1.47(a).

CONCLUSION

The petition to vacate the Notice Of Abandonment is **GRANTED**.

The "Notice Of Abandonment Under 37 CFR 1.53(f) Or (g)" mailed 06 January 2003 is hereby **VACATED**.

The petition under 37 CFR 1.42 and 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.42 and 1.47(a)" and should include the required materials discussed above, i.e., a statement demonstrating that Ms. Takahashi alone is the proper person to execute this application under 37 CFR 1.42, an express statement of the last known address of Ms. Takahashi, and evidence of a follow-up mailing to Ms. Takahashi again requesting her signature and making clear that a failure to timely respond will be treated as a refusal.

No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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